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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,696	08/31/1999	GEORGE GOICOECHEA	BSI-212	2901

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/387,696

Applicant(s)

GOICOECHEA ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2002.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 54-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The corrected or substitute drawings were received on June 21, 2002. The Examiner approves the drawings corrections of Figure 2A.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. **Therefore, the “hoop-like tubular portions”, “corrugated portions”, “straightened portions”, and “generally straight intermediate portions” must be shown or the feature(s) canceled from the claim(s).** No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 54-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The “hoop-like tubular portions”, “corrugated portions”,

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“straightened portions”, and “generally straight intermediate portions” were not disclosed/described in the specification.

**In other words, where in the specification is a description of “hoop-like tubular portions”, “corrugated portions”, “straightened portions”, and “generally straight intermediate portions”?**

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 54-59 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by MacGregor (US 4,994,071). MacGregor discloses a tubular prosthesis having a tubular surface being axially subdivided into two or more hoop-like tubular portions formed from corrugated portions of two or more wires or filaments and connected by straightened extension portions (see Abstract; column 2, lines 23-36; column 4, lines 1-10; Figures 1 and 1A). Regarding claim 54, it should be noted that Figure 1A clearly shows “at least two of said hoop-like tubular portions are axially arranged **generally adjacent to one another**”. Regarding claim 55, it should be noted that the apices, although of U-shaped form, could be modified into V-shaped form (well known in the art) without departing from the spirit of the invention. Regarding claim 56, Figure 1A shows the straightened extension portions slightly oriented skew relative to the tubular axis. Regarding claim 57 (as in claim 54), it should be noted that Figure 1A clearly shows tubular portions

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arranged “**generally adjacent to each other**”. Regarding claim 59, Figures 1 and 1A clearly shows consecutive hoop-like tubular portions “connected at a point circumferentially displaced from the straightened extension portions”. Claim 61 is a broader version of either claims 54, 55, 56, 57, and 59. Figures 1 and 1A clearly anticipate claim 61.

7. Claim 61 is rejected under 35 U.S.C. 102(b) as being anticipated by Maeda et al. (WO 93/13825). Maeda et al. disclose a stent meeting the general structure and limitations of claim 61 (see Abstract; page 5, lines 23-33; page 6, lines 13-16 and lines 25-27; page 9, lines 11-16; Figures 1, 3, and 6). Claim 61 broad claim language clearly reads on Figures 1, 3, and 6.

#### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacGregor (US 4,994,071) in view of Maeda et al. (WO 93/13825). MacGregor discloses the invention as substantially as claimed except for disclosing the straightened extension portions as extending in a helical path. However, Maeda et al. disclose an extension portion extending in a helical path between and connecting consecutive hoop-like tubular portions in order to impart uniform expansile force along the length of the stent (see page 3, lines 16-18; page 5, lines 16-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of using an extension portion extending in a helical path between

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and connecting consecutive hoop-like tubular portions, as taught by Maeda et al., with the tubular prosthesis of MacGregor, in order to impart uniform expansile force along the length of the stent.

### *Response to Arguments*

10. Regarding claims 54, 55, 56, 57, 59, and 61, Applicant's arguments filed June 21, 2002 have been fully considered but they are not persuasive. The response to the arguments has been adequately addressed in the 102(b) rejections.

11. Applicant's arguments with respect to claim 60 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:00 a.m.-4:30 p.m.), first Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



JGB

September 9, 2002



David H. Willse  
Primary Examiner